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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,535

09/05/2003

Michael Seul

PARSE-C4

8774

7590

07/05/2006

Bioarray Solutions
35 Technology Drive
Warren, NJ 07059

EXAMINER

DO, PENSEE T

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,535	Applicant(s) SEUL ET AL.	
	Examiner Pensee T. Do	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50 and 55-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50, 55- 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/5/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment Entry & Claim Status

The preliminary amendment filed on October 20, 2005 has been acknowledged and entered.

Claims 50, 55-61 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 59-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 59, line 3, recites "an electric fields" which is indefinite because it is unclear of how many electric fields there are. Please make appropriate correction.

Claim 60 is indefinite for reciting in line 2, that "the substrate and the planar electrode". The substrate is defined in line 1 as a planar electrode. Thus, it is unclear which electrode (the substrate or the other planar electrode), the "planar electrode" in line 2 is being referred to.

Claim 61 is indefinite because it recites "the electric field and the illumination pattern .." which lack antecedent support. Claim 61 depends from claim 56 which fails to recite "the electric field and the illumination pattern...".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 50, 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickinson et al. (US 6,942,968).

Dickinson teaches a method of forming a matrix of a random arrays (see col. 8, lines 1-19) on a substrate comprising randomly placing the a population of particles, comprising at least two subpopulations, wherein the particles are encoded with labels, wherein differently encoded particles have a different label, into one or more sites on the substrate having a plurality of sites (see col. 24, lines 1-12; col. 30, lines 40-60); recording the position of the particles (col. 25, lines 52-53; col. 31, lines 41-45). With respect to claim 50, Dickinson teaches that differently encoded beads/particles have different biological reagents bound thereto (see col. 30, lines 40-60; col. 20, lines 8-25). With respect to claim 55, Dickinson teaches the substrate is silicon or doped silicon (see

col. 9, line 5). With respect to claim 57, Dickinson teaches that the arrangement of the particles in the sites is random. (see col. 8, lines 1-19).

Remarks

It has been noted that the instant application is a CON of 09/365,993 which is a CON of 09/768,414, filed on January 24, 2001, which is a CON of 09/397,793 filed on September 17, 1999, which is a CIP of 09/171,550 filed on October 26, 1998. However, the subject matter claimed by the applicant was introduced in the application number 09/397,793 in which was filed on September 17, 1999. Therefore, the effective filing date of the instant application is September 17, 1999.

Claims 59-61 as now recited as free of prior arts.

The prior arts fail to teach that the particles are confined in the sites by placing the particles in electrolyte solution on a substrate and then applying an electric field to translocate and confine the particles into the sites; and the substrate is a planar electrode, and the method comprises another planar electrode facing the substrate and the electrolyte solution is located between the electrodes, wherein one electrode is light sensitive and an illumination pattern projected thereon is used in conjunction with the electric field, to translocate the particles to the illuminated areas of in the pattern; and the electric field and the illuminated pattern are controlled by a computer.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 8:00-4:00.

Art Unit: 1641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pensee T. Do
Patent Examiner
June 23, 2006


LONG V. LE
SUPERVISORY PATENT EXAMINER
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06/26/06